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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,783	11/20/2001	Jean Prevost	1912-0253P	9224

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EXAMINER

BOSS, WENDY L

ART UNIT	PAPER NUMBER
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1775

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DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,783

Applicant(s) **MS**

PREVOST, JEAN

Examiner

Wendy Boss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/947,881.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's preliminary amendment submitted November 20, 2001 has not been entered. The amendment gave instructions to cancel claims 1-30; however, only claims 31-56 were originally submitted.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 31-56 have been renumbered 1-26.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. In claim 22, it is not clear what is meant by the formula $2A = 3/2T \leq L$. The examiner could not find support in the specification for such a relationship.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,396,653 (Tomarin).

Tomarin discloses a synthetic grass surface for a sports playing field wherein the synthetic grass surface comprises a flexible backing member, parallel rows of synthetic ribbons, representing blades of grass, projecting upwardly from the backing member, the rows of ribbons spaced apart from each other (see Figure 2; and column 3, lines 31-35). At column 4, lines 49-68, Tomarin discloses that the surface includes a relatively thick layer of particulate material on the backing member supporting the ribbons in a relatively upright position relative to the backing member. The relationship of the length of the ribbons and spacing between the rows in the reference is such that the length of the ribbons is between 3 and 6 times the spacing (see column 3, lines 20-35). It is also disclosed in the reference that the particulate layer may have a thickness covering the full height of the ribbons (see column 4, lines 15-18), which satisfies the limitation of at least two-thirds of the length as recited in claim 13.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,396,653 (Tomarin) in view of U.S. Patent No. 5,794,861 (Rutherford, Sr.).

Tomarin discloses a synthetic surface as shown above in paragraph number 7. Tomarin also discloses that the particulate layer is a mixture of sand and rubber. Tomarin does not necessarily disclose that the rubber of the particulate material is cryogenically ground rubber. At column 3, lines 63-66, Tomarin teaches that the rubber may be crumb rubber produced from scrap vehicle tires. Attention is directed to column 3, lines 59-63 of Rutherford, which teaches that it is well known to subject vehicle tires to cryogenic fluids when they are recycled to form crumb rubber. It is therefore within the level of one having ordinary skill in the art to use crumb rubber obtained by a cryogenic grinding process in the Tomarin turf.

10. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,337,283 (Haas, Jr.) in view of U.S. Patent No. 5,794,861 (Rutherford, Sr.).

Haas discloses a synthetic surface having a flexible backing member, parallel rows of synthetic ribbons, representing blades of grass, projecting upwardly from the backing member, the rows of ribbons spaced apart from each other (see column 2, lines 60-68; and column 4, lines 13-24). In Figure 1 of the reference, it appears that the length of the ribbons, extending upwardly from the backing member is at least twice the dimension of the spacing between the rows of

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ribbons. At column 3, lines 35-38, Haas discloses that the surface includes a relatively thick layer of particulate material on the backing member supporting the ribbons in a relatively upright position relative to the backing member. The reference also discloses that the length of ribbons extending upwardly from the backing member may be 2 inches, which is within the range recited in applicant's claim 2 (see column 4, lines 22-25). It is also disclosed in the reference that the particulate layer may have a thickness of at least two-thirds of the length, and that the ribbons extend between $\frac{1}{4}$ inch and 1 inch above the layer of particulate material (see column 5, lines 27-35), as recited in claims 3 and 4. The backing member in the reference is a single layer of permeable fabric (see column 3, lines 31-34), as recited in claim 6. Haas also discloses that the particulate layer is a mixture of sand and ground rubber wherein at least a portion ranges between fifteen and thirty mesh (see column 7, lines 40-48).

Haas does not specifically disclose that the rubber of the particulate material is cryogenically ground rubber. At column 7, lines 40-48, Haas teaches that the rubber may be rubber produced from scrap vehicle tires. Attention is directed to column 3, lines 59-63 of Rutherford, which teaches that it is well known to subject vehicle tires to cryogenic fluids when they are recycled to form rubber particulate. It is therefore within the level of one having ordinary skill in the art to use rubber particulate obtained by a cryogenic grinding process in the Haas turf.

The Haas also reference does not specifically disclose that the ribbons are spaced apart from each other from between $\frac{5}{8}$ inch and 2- $\frac{1}{4}$ inches; however, attention is directed to column 4, lines 14-24, which teaches that the density of the tufts varies depending on the

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intended use of the turf. Such a teaching would have motivated one having ordinary skill in the art to vary the spacing of rows accordingly.

Haas also does not disclose that the backing member is needle punched; however, patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). It is also not disclosed that the backing member is a double layer or triple layer of permeable fabric; however, it would have been obvious to one having ordinary skill in the art that using multiple layers of fabric would improve the structural integrity of the turf.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 21 of prior U.S. Patent No. 6,338,885. This is a double patenting rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy Boss whose telephone number is 703-306-5922. The examiner can normally be reached on M-Th 8:30a-6:00p; 2nd F 8:30a-5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Wendy Boss
August 6, 2002



ARCHENE TURNER
PRIMARY EXAMINER
GROUP 1300